

### REMARKS

Reconsideration of the application is requested.

Claims 1-5 and 7-14 are now in the application. Claims 1-5 and 7-14 are subject to examination. Claims 1 and 7 have been amended. Claims 13 and 14 have been added.

Item 2 of the Office action states that the latest Office action is a final action. Counsel spoke with the Examiner on November 9, 2010 and the Examiner verified that the Office action is not a final action.

Under the heading "Claim Rejections – 35 USC § 103" on page 2 of the above-identified Office Action, claims 1 and 7 have been rejected as being unpatentable over U.S. Publication No. 2005/0192913 A1 to Lubart in view of U.S. Publication No. 2001/0049745 A1 to Schoeffler, and further in view of U.S. Publication No. 2002/0120668 A1 to Pintsov et al. under 35 U.S.C. § 103.

Support for the changes to claims 1 and 7 is inherent in claims 1 and 7 as previously presented. Support for claims 13 and 14 can be found by referring to Fig. 2. Claims 13 and 14 merely clarify that the post is an item of mail.

Lubart teaches that a pseudo name is displayed on the post (paragraph 47). The Examiner has stated that Lubart teaches "scanning an address face of the

post for a TAG ID". It appears that the Examiner has equated the pseudo name with the claimed TAG ID".

Lubart teaches that the pseudo name is scanned to determine if there is a profile associated with the pseudo name (paragraphs 49, 73). Lubart teaches that many different profiles can be associated with a pseudo name (paragraphs 41, 42 and 43). Lubart teaches that each "profile" has a designated time frame during which the "profile" is active (paragraph 45). For example, a dated "address profile" may be updated to send all mail items to IBM Chicago for the next 10 days (paragraph 44).

The Examiner has stated that Lubart teaches consulting a database for records related to the TAG ID, wherein the records contain information indicating if said TAG ID specific to the post is expired. Applicant believes the Examiner is referring to steps 130 and 140 in which a profile associated with the pseudo name determined and in which a dynamic mail function, such as, the follow me profile is accessed.

The Examiner has alleged that Lubart teaches determining if the TAG ID is expired. However, the Examiner has equated the pseudo name with the claimed TAG ID, and Lubart does not teach determining if the pseudo name is expired. Rather, Lubart teaches determining if an address profile, which is associated with the pseudo name, is expired. The alleged ID TAG, namely, the pseudo name is always assumed to be valid.

Furthermore, the limitation in claim 1 reads, "if the TAG ID specific to the post is expired: automatically determining if an addressee of the post maintains a forwarding service account ...". The Examiner alleges that Schoeffler would have suggested incorporating such a change into Lubert. Schoeffler teaches that after an item of mail is returned to the sender because the recipients address is non-functional, then the sender manually sends the item of mail to a forwarding service (paragraphs 38 and 39). The forwarding service maintains a database in which a forwarding address is paired with the non-functional address (paragraphs 38, 39, 46, and 47). Thus, first of all, Schoeffler's method is not automatic since the item of mail is returned to the sender and the sender must then send the item of mail to the forwarding service. Therefore, the claimed method could not have been suggested.

Further, Schoeffler teaches a different system that would not be obviously combined with the system of Lubert. Lubert relies on their own database to find the profile with the proper address that is associated with the pseudo name displayed on the item of mail. The value of Lubert's system is that once the client sets up the profiles everything is automatic. The client updates the profiles to ensure that the mail is forwarded to the desired location. As mentioned above, Schoeffler's method is inferior to that of Lubert since the mail is returned to the sender and the sender must then provide the item of mail to the forwarding service. No one would have obtained a suggestion to modify Lubert's method based on that of Schoeffler.

The Examiner alleges that incorporating the system of Pintsov et al. would have resulted in preventing the need for an additional envelope. Applicant believes this allegation is clearly incorrect since the unique serial number relates to insuring that prepaid postage is utilized only one time (paragraphs 11 and 12). There is no teaching that the unique serial number is provided to save envelopes. Therefore, applicant first asserts that motivation alleged by the Examiner is not valid. Furthermore, the unique serial number of Pintsov et al., which is provided to insure that postage is used only once, would not have suggested a modification to the ID TAG of Lubert, namely, the pseudo name, which is used to find the associated profile with an address.

The invention as defined by claim 7 includes limitations that are similar to those of claim 1 that have been discussed above, and would not have been suggested for the reasons given above.

Applicant also provides the following additional discussion and rationale. The invention relates to a method for forwarding of mail items with the guarantee of payment from the mail item recipient in case of the forwarding. There are three main aspects of the claimed invention:

- (a) The invention uses a TAG ID specific to a mail item. Such a specific TAG ID is provided on an address face of a mail item and will be read by scanning and evaluating the address face of the mail item.

- (b) The invention uses a database for records related to said specific TAG ID wherein the records contain information indicating whether or not said TAG ID specific to the mail item is expired. The claimed method checks a scanned specific TAG ID by using the database to decide if said TAG ID specific to the mail item is expired.
- (c) If the check yields the result that the TAG ID specific to the mail item is expired the method processes specific actions:  
automatic determination if an addressee of the mail item maintains a forwarding service account, and if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address.

As a consequence of that process - a mail item will only be forwarded:

- (i) If the TAG ID specific to the mail item is expired and
- (ii) the addressee of the post maintains a forwarding service account and the forwarding service account is maintained and
- (iii) debiting the account automatically in an appropriate amount.

This process according to the invention guarantees the "payment" from the mail item recipient in case of forwarding.

In making the rejection under 35 U.S.C: 103, the Examiner referred to rationale D, Examination Guidelines for Determination Obviousness under 35 U.S.C. 103, III Rationales to support rejections under 35 U.S.C. 103.

Rationale D to support a conclusion that a claim would have been obvious is that a particular known technology was recognized as part of the ordinary capabilities of one skilled person in the art. One person of ordinary skill in the art would have been capable of applying this known technique to known device (method, or product) that was ready for improvement and the results would have predictable to one ordinary skill in the art (see Department of Commerce, Patent and trademark Office, Docket No. PTO-P-2007-0031, Federal Register / Vol. 72, No. 195).

On page 6 of the Office Action the Examiner explains that combining Pintsov with Schoeffler would be done by applying ordinary skill in the art and the way that this combination would lead to an improvement (of a base device/method) and would have predictable results.

Such argumentation fails to support the conclusion that the claimed invention would have been obvious over Lubart in view of Schoeffler and in further view of Pintsov as long as the Examiner applies Pintsov (only) to Schoeffler. This argumentation may lead to an improvement of the base device/method as disclosed by Schoeffler. But it fails to give reasons for obviousness over Lubart as the base device/method for the claimed invention.

Further – rationale D requires the application of a technology to a base device/method. But “applying a technology” means to look for the teaching one

ordinary skill in the art would get from prior art. The teaching could not be limited to a single limitation as such without respecting the context, i.e. the function of that limitation as is taught by prior art. Only the application of a known technology in this understanding (limitation and teaching of that limitation) will lead to “predictable results” as seen by rationale D. Otherwise a combination of a single limitation in other context/functions will lead to surprisingly results. But a surprisingly result will be a sign for an inventive step.

The Examiner combines Schoeffler by applying the single method step, “if the TAG ID specific to the mail item (post) is expired, automatically determining if an addressee of the post maintains a forwarding service account”. But the Examiner does not consider the condition for that single method step as well as the results of that single method step as taught in prior art. Only the consideration of all this aspects could define a technology to be used for a support under rationale D. Therefore an application of a single method step – separated from a complex method and implemented in another method – could never be an “application of a know technologies” as well as it could never yield predictable results.

Schoeffler discloses a method of shipping a mail item to a known address of a recipient. If this address is not valid, the sender will retrieve the mail item and will receive a failure message. The sender now attempts to contact the recipient by sending the mail item to a forwarding service where the recipient may have registered his expired address and his current address to which

communications are to be forwarded. The forwarding service looks up expired addresses in the directory. If there is a corresponding new address, the new address is retrieved from the directory, and the mail item is forwarded 11 to the recipient (Schoeffler, [0038] and [0039]):

“[0038] Referring to the block diagram of FIG. 1, and also the flowchart of FIG. 3, Sender 1 of communication in a particular medium (e.g. telephone, electronic mail, postal mail) attempts to contact intended recipient by sending a message 2 using known address 3. Recipient's former or non-operational communication service replies 4 with message saying the intended recipient's address is non-functioning, doesn't exist, the sender's message is blocked for lack of authorization, compatibility, or other reason, etc. (or there is no response from the recipient's communication service or recipient and the sender assumes there is a problem with the address or the service).

[0039] Sender 1 now attempts to contact recipient by sending the message 5 to forwarding service 6 (separate from standard communications channel provided by first communications service) where recipient may have registered his old address 3 and his current address 7 to which communications are to be forwarded. Forwarding service 6 looks up 8 old address 3 in the directory 9. If there is a corresponding new address, the new address is retrieved 10 from the directory 9, and the communication is forwarded 11 (connected) to the



recipient. Recipient's response 12 to sender's communication 11 may take place via forwarding service 6 or via a separate direct path 13. (This may depend primarily on whether the medium of the communication is interactive (e.g. the telephone) or one-way (e.g. postal mail).)

Therefore, Schoeffler discloses a communication technology that teaches to take the use of a forwarding service in case of failed delivery which only could be applied under rationale D in total.

The Examiner combines Pintsov by applying a "unique identifier" as disclosed by Pintsov. But the Examiner disregards that fact that the specific ID as taught by Pintsov is used for authorization and verification purpose (Pintsov, [0002] and [0011]):

"[0002] The present invention relates to mail processing systems, and more particularly, to mail processing systems employing a unique mail piece authorization for each mail piece of a series of mail pieces. The authorization, such as a unique identifier, is assigned in advance of delivery of the mail pieces to the carrier service and is used by the carrier service in processing the mail.

[0011] Systems and methods embodying the present invention involve creating a mailing list including destination addresses for mail pieces to be submitted to a carrier service for delivery. A unique mail piece

identifier associated with mail pieces on the mailing list is generated by the carrier service. The unique mail piece identifier is printed on the mail piece with which it is associated. The mail pieces are submitted with the printed unique identifier to the carrier service. The carrier service obtains from the mail piece the printed unique identifier. The obtained unique identifier from each said mail piece is utilized to verify that data associated with the mail piece has been processed by the carrier service."

In contrast to that technology of a "unique identifier" as taught by Pintsov, the claimed invention uses the TAG ID specific to the mail item as the elementary parameter for a method that will guarantee a payment from the mail item recipient in case of forwarding. The application of Pintsov's "unique identifier" – technology would not lead to the limitations of the claimed invention nor would it yield predictable results.

Rationale D as used by the Examiner could not be a support for the rejection.

Further, Neither Lubart nor Schoeffler discloses the use of TAG ID specific to the mail item. Neither Lubart nor Schoeffler discloses the "expiration-check" of the TAG ID specific to the mail item. Neither Lubart nor Schoeffler disclose the sequence of interdependent steps of automatically determining if an addressee of the post maintains a forwarding service account, and if the forwarding service account is maintained, debiting the account automatically in an

appropriate amount and forwarding the post to an addressee destination address, if the TAG ID specific to the mail item is expired.

Only these interdependent steps – controlled by the expiration-check of the TAG ID specific to the post - can guarantee the forwarding of the mail item to an addressee destination address with a payment from the post's recipient in case of that forwarding.

Pintsov discloses a method for processing mail item. Pintsov's method uses a TAG ID specific to a mail item provided on an address face of the mail item and read by scanning the address face of the mail item. Pintsov checks whether the specific ID is known by the system and was used before. If the specific ID was used before a reject message is generated, the mail item will not be processed based on this message (Pintsov, [0076], Fig.8).

But Pintsov does not disclose the step of consulting a database for checking if said TAG ID specific to the mail item is expired. The wording “expired” as used in the claims implicate a period of time when the TAG ID specific to the mail item will be valid. After an expiration date the specific TAG ID will be invalid. Therefore the invention made a “time-check” for the TAG ID specific to the mail item. However Pintsov teaches a “number-check” of the specific ID checking if the specific ID was used before. These different types of checks will also lead to different functionalities and results. A “time-check” can not give the guarantee that the specific TAG ID will be used twice during the period when

the specific TAG ID is valid whereas a “number-check” can not give the guarantee that the specific ID is used in due time, for example for that time a forwarding is necessary.

Further, Pintsov does not disclose interdependent steps of automatically determining if an addressee of the mail item maintains a forwarding service account and if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address, if the TAG ID specific to the post is “invalid”.

Pintsov leads the expert just in the opposite direction – according to Pintsov the mail item will not be forwarded if the specific ID is invalid. Any application of Pintsov’s specific ID to a process whatever cannot lead to the claimed invention. It just will lead away from the claimed invention.

Neither Lubart or Schoeffler nor Pintsov discloses the limitation of the “expiration-check” as handled by the claimed invention as well as the limitations of interdependent steps of automatically determining if an addressee of the mail item maintains a forwarding service account, and if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address, if the TAG ID specific to the post is expired.

For this reason applicant believes that claim 1 is not obvious by a combination of Lubart in view of Schoeffler and in further view of Pintsov, nor by any combination of Lubart, Schoeffler or Pintsov with any other document cited.

Under the heading "Claim Rejections – 35 USC § 103" on page 9 of the above-identified Office Action, claims 2-3 and 8-9 have been rejected as being unpatentable over U.S. Publication No. 2005/0192913 A1 to Lubart in view of U.S. Publication No. 2001/0049745 A1 to Schoeffler, further in view of U.S. Publication No. 2002/0120668 A1 to Pintsov et al., even further in view of U.S. Patent No. 6,405,243 to Nielsen under 35 U.S.C. § 103. Applicant respectfully traverses.

Applicant believes the invention as defined by claims 2-3 and 8-9 would not have been suggested for the reasons given above with regard to claims 1 and 7.

Under the heading "Claim Rejections – 35 USC § 103" on page 12 of the above-identified Office Action, claims 4 and 10 have been rejected as being unpatentable over U.S. Publication No. 2005/0192913 A1 to Lubart in view of U.S. Publication No. 2001/0049745 A1 to Schoeffler, further in view of U.S. Publication No. 2002/0120668 A1 to Pintsov et al., even further in view of U.S. Patent No. 6,405,243 to Nielsen, even more further in view of U.S. Publication No. 2002/0165729 A1 to Kuebert et al. under 35 U.S.C. § 103. Applicant respectfully traverses.

Applicant believes the invention as defined by claims 4 and 10 would not have been suggested for the reasons given above with regard to claims 1 and 7.

Under the heading "Claim Rejections – 35 USC § 103" on page 13 of the above-identified Office Action, claims 5 and 11 have been rejected as being unpatentable over U.S. Publication No. 2005/0192913 A1 to Lubart in view of U.S. Publication No. 2001/0049745 A1 to Schoeffler, further in view of U.S. Publication No. 2002/0120668 A1 to Pintsov et al., even further in view of U.S. Patent No. 6,405,243 to Nielsen, even more further in view of U.S. Publication No. 2002/0165729 A1 to Kuebert et al., even more further in view of U.S. Publication No. 2004/0020978 A1 to Webb under 35 U.S.C. § 103. Applicant respectfully traverses.

Applicant believes the invention as defined by claims 5 and 11 would not have been suggested for the reasons given above with regard to claims 1 and 7.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1 or claim 7. Claims 1 and 7 are, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1 or claim 7.

In view of the foregoing, reconsideration and allowance of claims 1-5 and 7-14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Stermer LLP, No. 12-1099.

Respectfully submitted,

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